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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,919	10/27/2000	Jason R. Albright	BLD920000063US2	8948
23334	7590	02/23/2004	EXAMINER	
FLEIT, KAIN, GIBBONS, GUTMAN, BONGINI & BIANCO P.L. ONE BOCA COMMERCE CENTER 551 NORTHWEST 77TH STREET, SUITE 111 BOCA RATON, FL 33487			NGUYEN BA, PAUL H	
		ART UNIT	PAPER NUMBER	
		2176	5	
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

<b>Application No.</b>	<b>Applicant(s)</b>	
09/702,919	ALBRIGHT ET AL.	
<b>Examiner</b>	<b>Art Unit</b>	
Paul Nguyen-Ba	2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1) Responsive to communication(s) filed on 10/27/04.  
2a) This action is FINAL.                                    2b) This action is non-final.  
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

4) Claim(s) 1-19 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) Claim(s) \_\_\_\_\_ is/are allowed.  
6) Claim(s) 1-19 is/are rejected.  
7) Claim(s) \_\_\_\_\_ is/are objected to.  
8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9) The specification is objected to by the Examiner.  
10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All    b) Some \* c) None of:  
    1. Certified copies of the priority documents have been received.  
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

1) Notice of References Cited (PTO-892)  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date 4.

4) Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_.  
5) Notice of Informal Patent Application (PTO-152)  
6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This action is in response to communications:
  - a. Original Application as filed on October 27, 2000, and
  - b. Information Disclosure filed on October 27, 2000.
2. Claims 1-19 have been considered. Claims 1, 13, 15, 16, 17 and 19 are independent claims.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 16-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 needs to be directed towards a “computer-implemented” method. Claims 16-18 recite a data structure stored on a computer-readable medium. The claimed data structure comprises non-functional descriptive data which renders the claim non-statutory. Mere data stored on a disk constitutes non-statutory subject matter because there exists no functional interrelationship.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Benade et al. (“Benade”), U.S. Patent No. 5,621,864.

**Independent Claim 1**

Benade discloses a *method of generating a variable data file to be used to generate custom printed articles* (see Abstract and Figures), *the method comprising the steps of:* *reading a template including a plurality of tokens* (see Summary; see col. 6, at line 34 through col. 10, at line 24; col. 15, lines 60+ → compare *plurality of tokens* with “*indicia*”); *generating a data structure including a plurality of printed article ID's* (see Summary; col. 5, lines 15-53; col. 6, lines 35-52; col. 13, lines 41-44; col. 16, lines 6-20 → database or data file used to drive the printer to produce *indicia* correspondence; see also Figure 13); *identifying a record in a database using a first printed article ID* (see Summary; col. 8, lines 1-5; col. 12, lines 30-34; col. 19, lines 43+ → matched to a database input); *and extracting data from a field of the record which is specified by a first token in the plurality of tokens* (see Summary; col. 8, lines 12-18, 36-56; col. 12, lines 26-30; col. 19, lines 43+ → *indicia generator responds to the selection of data input and generates the series of *indicia* specified*), *and*

*outputting the data to the variable data file* (see Summary; col. 5, lines 15-53; col. 8, lines 47-67 to col. 9, lines 1-10; col.13, lines 44-63).

**Claim 2**

Benade discloses the method according to claim 1 further comprising the steps of:

*incrementing an index to point to a second printed article ID in the data structure in response to reading a second token in the template* (see Figure 2; col. 12, lines 53-67 to col. 13, lines 40 → increments label count, the horizontal position variable, and the value of the label indicia).

**Claim 3**

Benade discloses the method according to claim 1 further comprising the step of:

*outputting plain text included in a third token to the variable data file* (see Figures 7 and 8; col. 2, lines 13-15; col. 4, lines 4-6; col. 9, lines 18-21; col. 17, lines 7-25 → i.e. “create text”).

**Claim 4**

Benade discloses the method of claim 1 wherein the step of identifying a record in a database comprises the step of:

*using the order ID and printed article ID to identify a record in a database* (see Summary; col. 8, lines 1-5; col. 12, lines 30-34; col. 19, lines 43+ → matched to a database input; col. 12, lines 53-67+ → order values as stored in database).

**Claim 5**

Benade discloses the method according to claim 1 wherein the step of generating a data structure comprises the sub-step of:

*producing an array of printed article IDs, in which the printed article IDs are arranged in order corresponding to the layout of corresponding printed articles on a printing medium (see col. 7, lines 7-28 → an array of n by m labels designated by definition).*

**Claim 6**

Benade discloses the method according to claim 1 further comprising the steps of:

*incrementing an index to point to a second printed article ID in the array in response to reading a second token in the template (see Figure 2; col. 12, lines 53-67 to col. 13, lines 40 → increments label count, the horizontal position variable, and the value of the label indicia; see also col. 7, lines 7-28).*

**Claim 7**

Benade discloses the method of claim 1 wherein the step of generating a data structure comprises the sub step of:

*generating a data structure comprising a plurality of entries, each of which includes a printed article ID (see Summary; col. 5, lines 15-53; col. 6, lines 35-52; col. 13, lines 41-44; col. 16, lines 6-20 → database or data file used to drive the printer to produce indicia correspondence; see also Figure 13).*

**Claim 8**

Benade discloses the method according to claim 1 further comprising the step of:

*calling a function specified by a function named in the first token to process the data (see col. 16, at line 21 through col. 19, at line 42 → Label Generator Application Functional Flow.*

**Claim 9**

Benade discloses the method according to claim 8 wherein processing performed by the function comprises a sub-step of:

*validating the data* (col. 16, lines 43-48 → Status Area is always active and reports error messages if data invalid).

**Claim 10**

Benade discloses the method according to claim 8 wherein processing performed by the function comprises a sub-step of:

*formatting the data* (col. 16, lines 50+ → i.e. label functions: create, copy, edit, etc.).

**Claim 11**

Benade discloses the method of claim 1 wherein the step of generating a data structure comprises the sub step of:

*generating an array having a number of columns equal to a number of columns in which printed articles are printed on a web, and a number of rows equal to a number of rows of printed articles to be printed on the web, in which each array entry includes a order ID and a printed article ID* (see col. 7, lines 7-28; col. 11, lines 32-67 to col. 12, lines 1-33; col. 14, lines 33+ → array matrix of n times m printed to web).

**Claim 12**

Benade discloses the method according to claim 11 wherein the step of generating a data structure comprises the sub-steps of:

*for each column in which articles are to printed on a web* (col. 14, lines 33-60):

*reading a first data structure which indicates a layout of groups of printed articles on the web to identify a group of printed articles at a group position on the web* (col. 12, lines 8-33 → retrieves data file from memory of processor to identify label and to generate layout);

*reading a second data structure which indicates an arrangement of printed articles within the group of printed articles to identify a printed article at a printed article position within the group* (col. 12, lines 53+ → increments label count and compared with maximum value to determine position within group of labels on the web),

*writing a printed article ID to an array which corresponds to the layout of printed articles on the web based on information read from the first and second data structures* (see col. 7, lines 7-28; col. 11, lines 32-67 to col. 12, lines 1-33; col. 14, lines 33+ → array matrix of n times m printed to web).

### **Independent Claim 13**

Benade discloses a *computer readable medium containing programming instructions for generating a variable data file to be used to generate custom printed articles* (see Abstract; Summary; see also col. 8, lines 5-15 and Figure 14 → program control instructions), the computer readable medium including programming instructions for:

*reading a template including a plurality of tokens* (see Summary; see col. 6, at line 34 through col. 10, at line 24; col. 15, lines 60+ → compare *plurality of tokens* with “indicia”);

*reading a data structure including a plurality of printed article ID's* (see Summary; col. 5, lines 15-53; col. 6, lines 35-52; col. 13, lines 41-44; col. 16, lines 6-20 → database or data file used to drive the printer to produce indicia correspondence; see also Figure 13);

*identifying a record in a database using a first printed article ID (see Summary; col. 8, lines 1-5; col. 12, lines 30-34; col. 19, lines 43+ → matched to a database input); and*

*extracting data from a field of the record which is specified by a first token in the plurality of tokens (see Summary; col. 8, lines 12-18, 36-56; col. 12, lines 26-30; col. 19, lines 43+ → indicia generator responds to the selection of data input and generates the series of indicia specified), and*

*outputting the data to the variable data file (see Summary; col. 5, lines 15-53; col. 8, lines 47-67 to col. 9, lines 1-10; col. 13, lines 44-63).*

#### **Claim 14**

Benade discloses the computer readable medium according to claim 13 wherein the programming instructions for generating a data structure include programming instructions for: *generating a array having a number of columns equal to a number of columns in which printed articles are printed on a web, and a number of rows equal to a number of rows of printed articles to be printed on the web, in which each array entry includes a order ID and a printed article ID (see col. 7, lines 7-28; col. 11, lines 32-67 to col. 12, lines 1-33; col. 14, lines 33+).*

#### **Independent Claim 15**

Benade discloses a system for producing custom printed articles comprising: *a high speed printer (see Figure 1; col. 5, lines 54-67 to col. 6, lines 1-33), a computer electrically coupled to the high speed printer the server (see Figure 1; Summary; col. 4, lines 55-67 to col. 5, lines 1-53), including:*

*a means for reading a template including a plurality of tokens* (see Summary; see col. 6, at line 34 through col. 10, at line 24; col. 15, lines 60+ → compare *plurality of tokens* with “indicia”),

*a means for reading a data structure including a plurality of printed article ID's* (see Summary; col. 5, lines 15-53; col. 6, lines 35-52; col. 13, lines 41-44; col. 16, lines 6-20 → database or data file used to drive the printer to produce indicia correspondence; see also Figure 13),

*a means for identifying a record in a database using a first printed article ID* (see Summary; col. 8, lines 1-5; col. 12, lines 30-34; col. 19, lines 43+ → matched to a database input),

*a means for extracting data from a field of the record which is specified by a first token included in the plurality of tokens* (see Summary; col. 8, lines 12-18, 36-56; col. 12, lines 26-30; col. 19, lines 43+ → indicia generator responds to the selection of data input and generates the series of indicia specified), and

*a means for outputting the data to a variable data file* (see Summary; col. 5, lines 15-53; col. 8, lines 47-67 to col. 9, lines 1-10; col. 13, lines 44-63).

### **Independent Claim 16**

Benade discloses a computer readable medium having stored thereon a data structure comprising:

*a text file* (see Figures 7 and 8; col. 2, lines 13-15; col. 4, lines 4-6; col. 9, lines 18-21; col. 17, lines 7-25 → i.e. “create text”) *including*:

*a field name identifying a field in a database* (see Figure 14; col. 16, lines 6-20; col. 19, lines 43-67 to col. 20, lines 1-16 → social security #, ID #, etc.), and  
*a setting which indicates a row and a column of a logical page* (see Figure 2 and 3; col. 7; lines 19-28; col. 12, lines 53-67 to col. 13, lines 1-40 → horizontal and vertical position on the N times M matrix).

### **Independent Claim 17**

Benade discloses a computer readable medium having stored thereon a data structure comprising:

*an array having a number of columns equal to the number of columns in which a plurality of printed articles are to be printed, and a number of rows equal to a number of rows in which the plurality of printed articles are to be printed, the array including a plurality of array entries each of which includes a printed article ID* (see col. 7, lines 7-28; col. 11, lines 32-67 to col. 12, lines 1-33; col. 14, lines 33+).

### **Claim 18**

Benade discloses the computer readable medium according to claim 17 wherein:  
*each array entry includes a printed article group ID* (see generally col. 11, lines 32+; col. 12, lines 34+; see specifically col. 13, lines 41-63 → generates a master data file of a designated group of labels).

### **Independent Claim 19**

Benade discloses a system for producing custom printed articles comprising:  
*a high speed printer* (see Figure 1; col. 5, lines 54-67 to col. 6, lines 1-33),

*a computer electrically coupled to the high speed printer the server (see Figure 1;*

*Summary; col. 4, lines 55-67 to col. 5, lines 1-53) including:*

*a processor programmed to (see Figure 1; Summary; col. 4, lines 55-67 to col. 5, lines 1-53; see also col. 8, lines 5-15 and Figure 14):*

*read a template including a plurality of tokens (see Summary; see col. 6, at line 34 through col. 10, at line 24; col. 15, lines 60+ → compare plurality of tokens with “indicia”),*

*read a data structure including a plurality of printed article ID's (see Summary; col. 5, lines 15-53; col. 6, lines 35-52; col. 13, lines 41-44; col. 16, lines 6-20 → database or data file used to drive the printer to produce indicia correspondence; see also Figure 13);*

*identify a record in a database using a first printed article ID (see Summary; col. 8, lines 1-5; col. 12, lines 30-34; col. 19, lines 43+ → matched to a database input);*

*extract data from a field of the record which is specified by a first token included in the plurality of tokens (see Summary; col. 8, lines 12-18, 36-56; col. 12, lines 26-30; col. 19, lines 43+ → indicia generator responds to the selection of data input and generates the series of indicia specified), and output the data to a variable data file(see Summary; col. 5, lines 15-53; col. 8, lines 47-67 to col. 9, lines 1-10; col. 13, lines 44-63).*

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6505980 B1	USPAT	20030114	Allday, Nik
US 5467433 A	USPAT	19951114	Lamprecht, Jr., Dale E. et al.
US 4939674 A	USPAT	19900703	Price, Macy J. et al.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (703) 305-8776. The examiner can normally be reached on 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PNB



**JOSEPH FEILD**  
**SUPERVISORY PATENT EXAMINER**